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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,067	01/10/2001	Jerry Dwayne Holland	12350.0008	7121

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EXAMINER

CULBERT, ROBERTS P

ART UNIT

PAPER NUMBER

1763

DATE MAILED: 03/11/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/758,067

Applicant(s)

HOLLAND ET AL.

Examiner

Roberts Culbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-62 is/are pending in the application.
- 4a) Of the above claim(s) 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22-62 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

This application contains claim 62 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Response to Arguments*

Applicant's arguments filed 2/28/03 have been fully considered but they are not persuasive.

Applicant has argued that the '333 reference does not disclose the use of soft *plastic* or *metal* media and therefore does not anticipate the currently pending claims.

This argument is moot in view of the new rejections that follow.

Applicant has argued that both the '466 reference and the '544 reference disclose using abrasive media, and therefore do not anticipate or, in combination with the '333 reference render obvious the currently pending claims. However the '466 reference clearly does show non-abrasive media as required by applicants definition on page 5, Lines 7-9 of the specification. See column 4, lines 65-70 of the '466 reference. The wear rate for formula XIX is approximately 0.00111lbs/hr for 15.71 lbs of media. Further, there is no reason provided by applicant that either the plastic media or the stainless steel media are "abrasive" by any definition.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43 and 60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. There is no support in the specification for the combination of metal and plastic media as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35, 38, 41, 42, 56, and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A trademark or trade name may not be used in a claim as a limitation to identify or describe a particular material or product. See MPEP 2173.05(u).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,818,333 to Michaud et al. in view of U.S. Patent 3,684,466 to Petrone

Michaud teaches a method for finishing a metal article including placing the metal article in a agitating finishing apparatus (col. 2, lines 31-32), contacting with a solution capable of converting the surface of the metal to a softer form (col. 2, lines 29-30), introducing nonabrasive media elements (col. 2, lines 35-36 and col. 3, lines 6-11), and agitating the metal article, media, and solution for a period of time to enhance surface properties (col. 2, lines 31-32) such as smoothness (col. 1, lines 10-14) and brightness (col. 2, lines 17-21). The surface property of the metal is superior to that produced by non-

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abrasive ceramic media or other abrasive media (col. 5, lines 33-37). The finishing apparatus is vibratory (col. 3, lines 50-52). Michaud also teaches the apparatus operates at 1300 rpm (Col. 7, Line 7), at an amplitude of 4mm (Line 8) and a solution flow rate of about 0.3gal/hr/ft<sup>3</sup>. Michaud teaches a solution containing oxalates, phosphates, nitrates and peroxides (Col. 3, lines 16-26). Solutions also may include oxalic acid, nitrate and hydrogen peroxide (Col. 5, Line 54).

Michaud discloses the method of the invention substantially as claimed, but does not show the use of a non-abrasive media made from plastic or from alumina bonded with an unsaturated polyester resin.

Petrone does teach the use of a media made from alumina bonded with an unsaturated polyester resin. (See claims 1 and 2) It would have been obvious to one of ordinary skill in the art at the time of invention to use the media of Petrone in the apparatus of Michaud in order to increase the durability of the media as suggested by Petrone. (See col. 2 lines 5-7). Although petrone does not disclose the use of a particular solution with the media, It is clear from the background of Michaud that the combination of alumina with a plastic coating has already been contemplated in combination with the method in the prior art. See Michaud (Col. 1, Lines 15-20). Petrone does not teach the hardness, density or crystal size of the plastic media, however no evidence suggests that the claimed properties are not inherent in the Petrone media as the materials are the same, i.e. polyester resin. The many various shapes of the media are well known in the art. See Col. 1, lines 25-30 of Petrone for example.

Regarding claim 32, the dilution of a concentrate to form a solution is notoriously old and well known in the art of forming a solution. It would have been obvious to one of ordinary skill in the art at the time of invention to dilute the solution in the well-known manner.

Regarding claims 33 and 40, official notice is taken that the finishing of metals such as steel or brass is common in the art of finishing metal surfaces. It would have been obvious to one of ordinary skill in the art at the time of invention to apply the finishing treatment to a metallic surface such as steel or brass in order to provide specular brightness as shown by Michaud.

Regarding claim 39, Michaud teaches that the use of a burnishing solution is well known in the art of finishing metallic surfaces (Col 1, lines 32-42).

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Claims 45-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,818,333 to Michaud et al. in view of U.S. Patent 4,307,544 to Balz.

Michaud discloses the method of the invention substantially as claimed, but does not show the use of a media made from stainless steel.

Balz teaches that stainless steel is a suitable finishing media for use in a vibratory type finisher (col. 7, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of invention to use the media of Balz in the method of Michaud since Balz teaches the suitability of the media for the intended purpose. (See MPEP 2144.07)

Regarding claim 53, the dilution of a concentrate to form a solution is notoriously old and well known in the art of forming a solution. It would have been obvious to one of ordinary skill in the art at the time of invention to dilute the solution in the well-known manner.

Regarding claim 59, Michaud teaches that the use of a burnishing solution is well known in the art of finishing metallic surfaces (Col 1, lines 32-42).

Regarding claim 54, official notice is taken that the finishing metals such as steel or brass is common in the art of finishing metal surfaces. It would have been obvious to one of ordinary skill in the art at the time of invention to apply the finishing treatment to a metallic surface such as steel or brass in order to provide specular brightness as shown by Michaud.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (703) 305-7965. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (703) 308-1633. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

March 7, 2003

  
**SHRIVE P. BECK**  
**SUPERVISORY PATENT EXAMINER**  
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